

REMARKS

Status of the Claims

Claims 1-9 are pending in the application. Claims 1-3, 5, 6, 8 and 9 have been rejected, and claims 4 and 7 are objected to. Claim 11 has been added and is supported by the disclosure of Example 2. Claim 1 has been amended.

Objection to the Claims

The Examiner objects to claim 1 for having a typographical error. Claim 1 has been amended to correctly read "and (4)" at line 17 (referencing PCT Application WO2005/085198 at page 32).

Rejection under 35 U.S.C. 103

The Examiner has maintained the rejection of claims 1-3, 5, 6, 8 and 9 under 35 U.S.C. 103(a) as allegedly being obvious over Kuduk et al (WO2004/019868), which is available as prior art only under 35 U.S.C. 102(e). As the Examiner pointed out in the office action of January 5, 2009, "[t]his rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP §706.02(l)(1) and §706.02(l)(2)." Thus, in accordance with the provisions set forth in MPEP §706.02(l)(2)(II), the following statement suffices as evidence to establish common ownership:

STATEMENT OF COMMON OWNERSHIP

The instant application and Kuduk et al were, at the time the invention in the instant application was made, subject to an obligation of assignment to Merck & Co., Inc.

Accordingly, Kuduk et al is disqualified under 35 U.S.C. 103(c) as prior art. Withdrawal of this ground of rejection is respectfully requested.

Rejection under 35 U.S.C. 112 (1st paragraph)

Claims 1, 2 and 9 remain rejected under 35 U.S.C. 112, first paragraph as allegedly not fully supported by an enabling disclosure of the specification. While Applicants continue to maintain that the rejection is without merit, in the interest of advancing the application to allowance Applicants have amended claim 1 to recite the first definition of R⁴ as

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"C₁₋₆alkyl optionally substituted with 1 to 3 groups independently selected from halogen, nitro, cyano, and SO₂R^d";. The amendment is made without prejudice and Applicants reserve the right to file one or more future continuing application to pursue canceled subject matter. The rejection is believed to have been overcome in view of the above amendment, and its withdrawal is respectfully requested.

Objection of Claims

Claims 4 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. The base claim is believed to be now allowable in view of the above amendment, and the objection of claims 4 and 7 is therefore obviated.

In light of the above amendment and remarks, applicants submit that the application is in condition for allowance. An early favorable action is respectfully requested. The Examiner is invited to telephone the undersigned if it is helpful to advance the application to allowance. The Commissioner is hereby authorized to charge any fees connected with this correspondence to Deposit Account No. 13-2755.

Respectfully submitted,

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